REMARKS / ARGUMENTS

Claims 1, 4, 5, and 29-31 have been amended; Claims 2-4 and 6-8 have been canceled, without prejudice or disclaimer; Claims 18-26 have been withdrawn; and new Claims 32-37 have been added; therefore, Claims 1, 5, and 9-37 are pending, of which Claims 18-26 have been withdrawn from consideration. Applicants have carefully considered the application in view of the Examiner's action and, in light of the foregoing amendments and the following remarks, respectfully request reconsideration and full allowance of all pending claims.

As a preliminary matter, it is noted that the name of the first named inventor is spelled Woodrow W. Gandy, as indicated on the Declaration and Assignment, not Woodrow W. Grandy as incorrectly indicated on the filing receipt and Office action. It is respectfully requested that the spelling of the first named inventor be corrected in the records of the Patent and Trademark Office.

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. US 2001/0029322 to Iliff (hereinafter "*Iliff*") in view U.S. Patent No. 6,154,726 to Rensimer et al. (hereinafter "*Rensimer*"). Claims 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Iliff*, *Rensimer*, and further in view of U.S. Patent No. 6,871,140 to Florance et al. (hereinafter "*Florance*"). Claims 27-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Iliff*, *Rensimer*, and further in view of U.S. Patent Pub. No. US 2002/0002502 to Maes et al. (hereinafter "*Maes*"). In response, Applicants have cancelled Claims 2-4 and 6-8, without prejudice or disclaimer, rendering the rejection thereof moot, Applicants have amended independent Claims 1 and 29 such that they now more clearly distinguish, and are patentable over the cited references, and Applicants hereby submit an affidavit prepared under 37 C.F.R. § 132 asserting commercial success of the claimed invention, thereby further rendering the claimed invention nonobvious.

Specifically, independent Claim 1 has been amended to more particularly point out and distinctly claim distinguishing characteristics of the subject matter which Applicants regard as their invention. Accordingly, Claim 1 has been amended to recite that the templates, inquiries, sub-templates, and modifiers are selected by a health care professional user, as supported in the application by original Claim 3 and by pars. 29, 31, 30, to name but a few, thereby adding no new matter to the application as originally filed. Claim 1 has also been amended to recite that

inquiries are configured for the entry of data relating to a <u>medical condition</u>, and that observation, testing and examination is of <u>a medical condition</u> of a patient by a health care professional user, as supported by original Figs. 9-15, 17-19, 21-28, and 30, and related text, thereby adding no new matter to the application as originally filed. Various other amendments have also been made to Claim 1 to correct informalities (e.g., articles relevant to antecedent basis issues) and to generally further clarify the subject matter being claimed as Applicant's invention, without adding any new matter to the application as originally filed.

Iliff has been cited as fully disclosing Applicant's invention as recited in Claim 1, including the limitations of Claims 3 and 4 which have been incorporated into Claim 1 as now amended. *Iliff*, however, fails to either teach or suggest templates, inquiries, sub-templates, or modifiers <u>selected by a user</u> for response. The Examiner has cited pars. 0032, 0035, and 0060 of *Iliff* as teaching the capacity to select a template. However, upon closer examination, it is apparent that pars. 0032 and 0035 by themselves are unclear regarding <u>who</u> or <u>what</u> selects portions of MDATA, scripts, or medical algorithms for presentation to a user. Paragraph 0060 refers to Fig. 23 (par. 0478 ff.) which is a <u>menu-driven</u> treatment selection process; that is, a process wherein a user responds to a question in a menu, and <u>based on the response to the</u> <u>question, a computer selects one or more further questions to ask</u>, or proposes a diagnosis or treatment for the user. Paragraph 0136 is even more clear on the issue, asserting that:

> "The course of an algorithm is determined by caller responses to questions that the MDATA system asks. For simple "yes/no" questions, the flow of interaction can be described by a binary tree. Multiple-choice questions (e.g., menus) provide multiple branches in the tree. Each question can be considered a node, and the acceptable responses to this question are branches leading to the next question (node). Using this abstraction of an algorithm, one can draw a directed graph (also known as a node map) of the nodes and branches of an algorithm, beginning with the initial question, and ending with all possible terminal points."

Clearly *Iliff* is in contrast to Applicant's invention, as recited in Claim 1 as amended, wherein a <u>user selects a template or a sub-template</u> having one or more inquiries (i.e., questions), and then the <u>user (not a computer) selects which inquiries (i.e., questions) to respond to</u>.

The Examiner noted that database 260 (Fig. 6, pars. 0196-0199) provides the capability for a user to access a selected database or selected template. In response, it is further noted that database 260 is limited to storage of identification data, such as a user's ID number, name,

gender, birth date, and the like. Database 260 does <u>not</u> provide for the storage or retrieval of data relating to a medical condition, and thus does not cure the deficiencies of *Iliff*.

Iliff also fails to teach or suggest data entry by at least one of observation, testing and examination of a patient by a health care professional user, for which *Rensimer* was cited. The Examiner has noted in particular that *Rensimer* is a "system and method that permits physicians and other medical staff personnel to record, accurately and precisely, the <u>treatment</u> and <u>care</u> given in a particular patient encounter" (emphasis added). *Rensimer*, however, fails to teach or even suggest recording a <u>medical condition</u>, as now claimed by Applicants in amended Claim 1. To the contrary, *Rensimer* is limited to recording <u>treatment</u> and <u>care</u> given to a patient, particularly data relating to treatment and care which is necessary for administrative purposes, billing, and insurance claims.

Furthermore, there is no teaching or suggestion in either *Iliff* or *Rensimer* to combine the two patents, as is required to support a rejection under 35 U.S.C. § 103(a). Even if there were such a teaching or suggestion, it is not at all clear <u>how</u> *Iliff* and *Rensimer* could be meaningfully combined, other than as two essentially separate, disparate programs packaged together, as could be done with any two programs. Even if, for the sake of argument, *Iliff* and *Rensimer* could be meaningfully combined, because the two programs are so disparate, there is no feature of one program that the other program does better, and hence no motivation to make such a combination. Still further, *Iliff* is directed to the general public (par. 0013), but *Rensimer* is clearly directed to medical professionals, such as doctors and nurses, further bringing into question what motivation there would be to combine the patents. Because motivation is also required to combine patents in support of a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that it is improper to combine *Rensimer* with *Iliff*, and it is thus requested that the rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* in view *Rensimer*, be withdrawn.

Still further, *Iliff* fails to teach or suggest a language program configured for producing a text report <u>based on data entered by the health care professional user</u> into the templates and sub-templates selected by the health care professional user, wherein the report utilizes modifiers to summarize the data. The language program allegedly taught by *Iliss* is cited by the Examiner at pars. 0701-0702 and Fig. 3, items 170 and 172. In response, Applicants first note that pars.

0701-0702 discuss program languages, not a language program, and that the program languages are <u>not</u> adapted for producing text reports. Second, items 170 and 172 of Fig. 3 (pars. 0130-0156) discuss a language program for authoring and encoding medical knowledge and questions into the MDATA system, <u>not</u> for producing a text report <u>based on answers from a user to the questions, or based on data entered by the health care professional user</u> into the templates and sub-templates selected by the health care professional user, much less such a report that utilizes modifiers to summarize the data.

In further support of the foregoing, Applicants hereby submit an Affidavit, attached herewith, prepared under 37 C.F.R. § 132 and MPEP 716.03, asserting commercial success of the claimed invention. Applicants believe that the Affidavit shows that the commercial success is commensurate in scope with the claims, and that the commercial success derived from the claimed invention. It is therefore respectfully submitted that the Affidavit supports Applicants' contention of nonobviousness.

In view of the foregoing, it is apparent that none of the cited references, either singularly or in any combination, teach, suggest, or render obvious the unique combination now recited in independent Claim 1. It is therefore respectfully submitted that Claim 1 clearly and precisely distinguishes over the cited combinations of references in a patentable sense, and is therefore allowable over those references and the remaining references of record. Accordingly, it is respectfully requested that the rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* in view *Rensimer*, be withdrawn.

Claim 29, as amended, is an independent method claim analogous to the system recited in independent Claim 1, as amended, having limitations corresponding to the limitations of Claim 1. For the reasons set forth above, Claim 29 is also deemed to be in condition for allowance, and it is respectfully requested that the rejection of independent Claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* in view *Rensimer* and *Maes*, be withdrawn, as well.

Claims 5, 9-17, 27, 28, and 30-32 depend from and further limit independent Claims 1 and 29, in a patentable sense, and, for this reason and the reasons set forth above, are also deemed to be in condition for allowance. Accordingly, it is respectfully requested that the rejections of dependent Claims 5, 9-17, 27, 28, and 30-32 be withdrawn, as well.

New Claims 32, 35, and 36 are supported by Claims 29, 1, and 5, respectively, as originally filed, and therefore add no new matter to the application as originally filed. New Claims 33, 34, and 37 are supported by original Figs. 9-15, 17-19, 21-28, and 30, and related text, and therefore add no new matter to the application as originally filed. For this reason and the reasons set forth above, Claims 32-37 are also deemed to be in condition for allowance.

Attached is a Petition for Extension of Time, along with authorization to charge the 37 C.F.R. § 1.17(a) fee for a one (1) month extension of time.
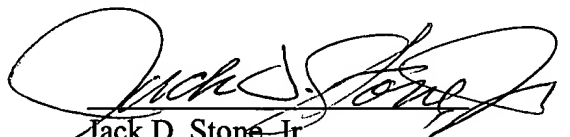
Applicant does not believe any fees are due in connection with the filing of this paper, other than fees associated with the attached Petition for Extension of Time; however, in the event that any other fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper, to Deposit Account No. 50-2032 of Scheef & Stone, L.L.P.

Applicant has now made an earnest attempt to place this application in condition for allowance, or in better condition for appeal. Therefore, Applicant respectfully requests, for the reasons set forth herein and for other reasons clearly apparent, full allowance of Claims 1, 5, 9-17, and 27-37 so that the application may be passed to issue.

Should the Examiner have any questions or desire clarification of any sort, or deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

SCHEEF & STONE, L.L.P.

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